

TTAB

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
TRADEMARK TRIAL AND APPEAL BOARD**

Applicant: First Draft, Inc.  
Serial No.: 76/420,605  
Mark: **FERN MICHAELS**  
Filed: June 13, 2002  
Final Office Action: November 20, 2003  
Trademark  
Examining Attorney: Leslie L. Richards, Law Office 106

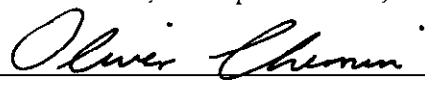
Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3514

September 14, 2004

**BRIEF ON APPEAL**

Oliver R. Chernin  
Attorneys for Applicant  
McLaughlin & Stern, LLP  
260 Madison Avenue  
New York, New York 10016  
(212) 448-1100

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Oliver R. Chernin

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**BRIEF ON APPEAL**

**I. INTRODUCTION AND DESCRIPTION OF RECORD**

This Appeal concerns an application for the mark **FERN MICHAELS**, the pen name of a best-selling author of romance novels. The application was filed on June 13, 2002 and seeks registration of the mark in connection with a series of books in International Class 16. In support of the application to register, applicant submitted specimens consisting of the back and front cover pages, the title page, and the copyright page of two separate books in Applicant's series of books. The applied for mark **FERN MICHAELS** appears prominently on the cover page and spine of the books.

On January 28, 2003, the Trademark Examining Attorney issued an Office Action refusing registration under Sections 1, 2 and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052 and 1127, on the ground that the proposed mark does not function as a trademark. Specifically,

the Trademark Examining Attorney argued that subject matter used solely as an author's name does not perform a trademark function.<sup>1</sup> Applicant filed a timely response, distinguishing the cases cited by the Trademark Examining Attorney and demonstrating that the applied for mark is registrable because it serves a dual function, it not only identifies the author of the series of books but also serves as an identifier of the products. In addition to its legal arguments, applicant noted that the Patent and Trademark Office ("PTO") has registered the name of authors in connection with a series of books on other occasions.

On November 20, 2000, the Trademark Examining Attorney issued a final refusal to register **FERN MICHAELS** for a series of books, based on the same grounds as the initial refusal. Concerning the PTO registrations for other marks, cited by Applicant, comprising authors' names and used in connection with a series of books, the Trademark Examining Attorney advised that "it is impossible to determine the manner in which such marks were used" and that a proper review of the relevance of these registrations had to include a review of the "specimens of record." *Final Office Action*, at p. 3.

On May 20, 2004, Applicant filed a timely Notice of Appeal with the Trademark Trial and Appeal Board ("TTAB"). In order to complete the Record of Appeal, Applicant submitted, with the Notice of Appeal, TARR printouts and file wrappers of seven (7) subsisting trademark registrations and a printout of a web page, providing additional information concerning one of the file wrappers. On June 9, 2004, the TTAB instituted the appeal but, in view of the materials

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<sup>1</sup> The Trademark Examining Attorney further required submission of a "Consent" to register **FERN MICHAELS**. Applicant complied with this requirement, advising that the mark **FERN MICHAELS** is the pseudonym of Mary Ruth Kuczkir, Applicant's principal, and submitted a properly worded "Declaration of Consent to Registration." Said "Consent" was accepted and is part of the record.

submitted with the Notice of Appeal, treated it as a Request for Reconsideration and remanded it to the Trademark Examining Attorney for reconsideration. On July 14, 2004, the Trademark Examining Attorney maintained her final refusal. In view of this decision, on July 16, 2004, the Trademark Trial And Appeal Board, resumed the appeal, setting a due date of September 14, 2004 for Applicant to file its Brief on Appeal.

## **II. STATEMENT OF ISSUES**

The trademark sought to be registered consists of the word mark **FERN MICHAELS**. The goods designated in the application are a “series of fictional books in International Class 16.” Registration has been refused under Sections 1, 2 and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052 and 1127, on the ground that the proposed mark does not function as a trademark. Specifically, the Trademark Examining Attorney argues that subject matter used solely as an author’s name does not perform a trademark function.

It is respectfully submitted that the Trademark Examining Attorney's refusal to register should be reversed for the following reasons:

- A. An author’s name is registrable as a trademark when used for a series of books where the mark serves a dual function, *i.e.*, it also serves as an identifier of the products.
- B. An author’s name is registrable when used with a series of books as demonstrated by the records of the Patent and Trademark Office.

## **III. RECITATION OF THE FACTS**

Applicant’s principal Mary Ruth Kuczkir has used the pseudonym **FERN MICHAELS** since at least as early as February 1975 to author romance novels. To date, Ms. Kuczkir has

written 67 successful romance novels, most of them New York Times bestsellers. She has sold over 60 million books in the United States and worldwide. In recognition of her success, she has been inducted into the New Jersey Literary Hall of Fame.

As is the case with many best selling authors (and particularly, with authors writing in a specific genre), the public has come to expect **FERN MICHAELS** books to be of a particular type, *i.e.* “romance novels,” of a certain quality, and to include certain types of characters. (For example, no **FERN MICHAELS** novel is complete without a prominent role for a dog.) It is the name **FERN MICHAELS** that primarily identifies and sells her books, not the name of her publisher or the title of each individual book. **FERN MICHAELS** fans will seek out books, bearing the mark, just as a consumer will seek out products marketed under a particular product name. (See the **FERN MICHAELS** web site, accessible at [www.fernmichaels.com](http://www.fernmichaels.com), for testimonials to her success.) Throughout her career, spanning more than a quarter century, **FERN MICHAELS** has not disappointed her readers. As a result, readers have come to identify the name **FERN MICHAELS** as the source of her novels and an assurance of the value and uniform quality of her works and the goodwill attached thereto. These qualities have translated into substantial sales for **FERN MICHAELS** books, a clear indicia that the term is considered as a mark designating source of the products.

There can be no doubt that the mark **FERN MICHAELS** is used in a traditional trademark manner. The designation **FERN MICHAELS** is displayed prominently on the various book covers and book spines submitted as specimens in a type face and size that clearly sets it apart from the surrounding wording. While it identifies her as an author, it also serves to confirm to the purchaser that a **FERN MICHAELS** book is a book of a particular quality, just as

a musical group's name on a record or CD promises a certain type and quality of music. This display clearly uses the mark in commerce, as required under the Trademark Act. "A mark is deemed to be used in commerce when it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto ... and the goods are sold or transported in commerce" § 45 of the Trademark Act, 15 U.S.C. §1127. Accordingly, there can be no issue that the specimens properly show the applied for mark.

#### **IV. ARGUMENT**

##### **A. AN AUTHOR'S NAME IS REGISTRABLE AS A TRADEMARK WHEN USED FOR A SERIES OF BOOKS WHERE THE MARK SERVES A DUAL FUNCTION, I.E., IT ALSO SERVES AS AN IDENTIFIER OF THE PRODUCTS**

The Trademark Act defines a trademark as follows: "The term 'trademark' includes any word, name, symbol, or device, and any combination thereof used by a person ... to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown. ... " §45 of the Trademark Act, 15 U.S.C. §1127. Applicant's mark **FERN MICHAELS**, as used, clearly falls within this definition - it is a designation that identifies a unique product, namely, **FERN MICHAELS** romance novels.

The case law on the registrability of author's names has been remarkably sparse, there has been no case that squarely deals with this issue. Instead, there have been discussions of the registrability of a newspaper columnist's byline, the registrability of an artist's name on works of art, and the registrability of the name of musical performers on records and CD's. While the overwhelming conclusion of the courts has been that marks are registrable where they also serve



as an indicator of the source of the products, the PTO has, in Applicant's view, misinterpreted the holding of one decision to stand for the proposition that registration of author's names for a series of books is foreclosed under all circumstances. Applicant respectfully requests the TTAB to reconsider this position in view of the following remarks.

The principal cases relied upon by the Trademark Examining Attorney, in support of her contention that an author's name can never function as a trademark are *In re Chicago Reader, Inc.*, 12 USPQ2d 1079 (TTAB 1989) and *Norcross v. Richardson*, 68 USPQ 371 (Com'r Pat. 1946), *aff'd*, 78 USPQ 122 (DC 1948). Applicant respectfully submits that a careful study of these cases must lead to the conclusion that their holdings are limited by the very specific facts and, therefore, do not control the determination as to whether **FERN MICHAELS** is registrable for a series of books.

*In re Chicago Reader, Inc.*, 12 USPQ2d 1079 (TTAB 1989), concerned an application for the mark **CECIL ADAMS** for a newspaper column. On the specimens of record, this mark appeared at the foot of the newspaper column, in the form of a byline. The column itself was prominently entitled *The Straight Dope* and was published weekly in applicant's paper entitled *Reader*. Applicant further made of record a single book comprising a compilation of **CECIL ADAMS** columns.

Based on an examination of the specimens comprising the newspaper column, *Id.*, at 1280, the TTAB found that the use of **CECIL ADAMS** on the specimens did not show use as a trademark but, rather, simply was a byline used to identify the author of the article. The TTAB found support for its determination by noting that the specimens provided explicitly referred to **CECIL ADAMS** as the author of the *Straight Dope* column, even providing an address where

readers could submit questions. Accordingly, the TTAB concluded that **CECIL ADAMS**, as used on the specimens of record, merely served to identify the author of the article and that it is not used nor would be recognized as a trademark identifying and distinguishing applicant's columns.

Applicant submits that the TTAB's decision to refuse registration to the mark **CECIL ADAMS** in *In re Chicago Reader, Inc.*, was based primarily on the fact that the use of mark was in such a non-prominent format that there was significant doubt that the mark, as used, identified and distinguished the newspaper column from that of others. Accordingly, the case simply stands for the proposition that an inconspicuous byline of a newspaper column does not amount to trademark usage.

In its decision, the TTAB also cited *Norcross v. Richardson*, for the proposition that the pseudonym of a writer is not generally regarded as a trademark for the writing.<sup>2</sup> However, this case also is not controlling on the present application. *Norcross* concerned the registrability of the mark **SUSIE CUCUMBER** employed as a pseudonym by a writer of various letters. The designation was applied to the letters solely in the form of a signature, *i.e.*, again in a very inconspicuous manner. A more persuasive analysis of *Norcross* was provided by the TTAB in

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<sup>2</sup> *Norcross* based its conclusion on the holding of the ancient case *Clemens v. Belford, Clark & Co.*, 14 Fed 728 (C.C.N.D. Ill 1983), which had concluded that Samuel Clemens could not prevent a reference to his pen name "Mark Twain" when publishing uncopyrighted literary works. The court did not rule out trademark protection to the author's use of his pen name, rather the court simply held that because Clemens had not obtained copyright protection for his works, anyone could publish them if they properly identified him as the author. *Kohler Co. v. Moen Incorporated*, 12 F.3d 632, 639, n. 9, 29 USPQ2d 1241, 1247, n.9 (7<sup>th</sup> Cir. 1992)

the well reasoned decision *In re Wood*, 217 USPQ 1345 (TTAB 1983), wherein the TTAB held that the name of an artist can and does function as the source identifier for artistic works.

That case concerned the issue whether an artist's signature on her paintings amounted to trademark use. The examiner had refused registration arguing that use of the artist's name did not show use in a trademark sense but "is merely informational in nature." *Id.* at 1346. The TTAB rejected this argument. After an historical excursion ranging from pottery made in ancient China (2700 B.C.) through the Middle Ages, to the present time, the TTAB demonstrated that artists have always used their name on a work of art to indicate the source of the product, *i.e.*, have used it in a trademark sense.

The TTAB distinguished *Norcross v. Richardson*. The TTAB reasoned that *Norcross* did not stand for the proposition that an author's name (or pseudonym) can never function as a trademark, rather, the case stood for the proposition that the pseudonym of a writer used on a series of letters may not prevent the republication of uncopyrighted matter under the author's name. *Id.* at 1346.

The TTAB stressed that the name of an artist on a work serves a dual function, it identifies the creator and, in addition, it serves a trademark function in that it identifies the source of the product and distinguishes it from the goods of another. *Id.* at 1348. The TTAB supported its analysis by citing to other examples in the field of entertainment; *i.e.*, In *In re Paramount Corporation*, 213 USPQ 1111 (TTAB 1982 (trademark significance found in character MORK & MINDY (on decals) which also performed non-trademark function); *In re Florida Cypress Gardens, Inc.*, 208 USPQ 288 (TTAB 1980) (holding CORKY THE CLOWN used in handbills identified not only a character but also the act or entertainment service performed by the

character); and *In re Carson*, 197 USPQ 554 (TTAB 1977) (holding JOHNNY CARSON was used not only as a name to identify the comedian but also as a service mark to identify entertainment services. *Id* at 1348.

The holding of *Wood* was confirmed by the TTAB in the more recent case *Michael S. Sachs, Inc. v. Cordon Art B.V.*, 56 USPQ2d 1132 (TTAB 2000). In that case, the TTAB dismissed Opposer's contention that the artist M.C. ESCHER's name used on reproductions of art cannot function as a trademark. At p. 1135, n. 8 the Board stated "[a]s a general comment, we would point out that the name of an artist, in addition to identifying the artist, may serve a trademark function if it identifies the source of a product and distinguishes it from the goods of another." Citing, *In re Wood*, 217 USPQ 1345 (TTAB 1983); *In re Grandma Moses Properties, Inc.*, 117 USPQ 366 (Com'r Pats 1958).

The issue of the registrability of an artist's name was also addressed in the context of musical groups. In *In re Polar Music International AB*, 714 F.2d 1567 (CAFC 1983), the Court of Appeals for the Federal Circuit reversed the determination of the TTAB that the name of a musical group ABBA was not registrable as a trademark to designate a series of musical recordings. Analogizing the use of the performers' name on records and tapes to a series of books, the court stated:

We find the present situation analogous. Every "ABBA" album and single and tape has the word "ABBA" on it in addition to its title. ... The public has come to expect and associate a certain quality, not just of sounds but how the sounds are produced on the record and the physical qualities of the record itself, with the mark "ABBA." Thus the mark "ABBA" indicates not just the source of the performance but a source of the records and tapes and the sound recorded thereon." *Id*, at 1572.

However, the court cautioned that “just showing the name of the recording group on a record will not by itself enable that name to be registered as a trademark. Where, however, the owner of the mark controls the quality of the goods, and where the name of that recording group has been used numerous times on different records and has therefore come to represent an assurance of quality to the public, the name may be registered as a trademark since it functions as one.” *Id*

This holding was confirmed in *In re Spirer*, 225 USPQ 693 (TTAB 1985), and has been incorporated into the TMEP at §1209.02(a). This section sets forth specific guidelines as to the circumstances under which performer’s names are registrable, as follows:

The following guidelines must be followed to ensure consistent action on applications to register the names of performers for sound recordings in accordance with *In re Polar Music International AB* and *In re Spirer*.

First, the names of performers may only be registered as a trademark if the mark is used on a series of sound recordings. The identification of goods must specifically indicate that there is a series. If the application does not identify the goods in this fashion, the examining attorney must require an appropriate amendment.

Secondly, the applicant must provide evidence that the mark has been applied to at least two different recordings in the series. In an intent-to-use application, the applicant must provide evidence of use on at least two recordings at the time the applicant files either the amendment to allege use or the statement of use. It is advisable to provide advance notice of this requirement during initial examination, where appropriate. If the applicant is unable to demonstrate use on a series, the mark may be registered on the Supplemental Register, provided it is otherwise proper. These procedures apply specifically to performers’ names used on recordings and not to other types of marks used on other types of artistic material.

Finally, it is only necessary to inquire about the applicant’s control over the nature and quality of the goods if information in the application record clearly contradicts the applicant’s verified statement that it is the owner of the mark or entitled to use the mark.

Applicant submits that the carefully crafted standard of TMEP §1209(a) is applicable to author's names on a series of books just as it is applicable to performer's names on sound recordings. There appears to be absolutely no rationale, in the Trademark Act or the case law to hold otherwise.

Accordingly, Applicant submits that the present application is controlled by the reasoning of *In re Wood*, *In re Polar Music International AB*, and *In re Spierer*. The mark **FERN MICHAELS** clearly meets the guidelines expressed in TMEP §1209(a). It is used on a series of books, Applicant controls the nature and quality of the goods (Applicant's principal is the sole author of the books), and it clearly serves to identify **FERN MICHAELS** as the source of these books.

Accordingly, the applied for mark can and does function as a mark.

**B. AN AUTHOR'S NAME IS REGISTRABLE WHEN USED WITH A  
SERIES OF BOOKS AS DEMONSTRATED BY THE RECORDS  
OF THE PATENT AND TRADEMARK OFFICE**

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The PTO has confirmed the applicability of TMEP §1202.09 proffered by Applicant (*i.e.*, that there no blanket PTO prohibition against registration of author's names except where such names are solely used to identify the author) by registering such names in connection with a series of books based on records strikingly similar to the present one. Thus, Applicant has made of record the file wrappers and TARR printouts of the following registrations:

- 1) Reg. No. 2,345,232  
Mark: PATRICIA CORNWELL  
Registered: April 25, 2000  
Goods: Series of fiction books

- 2) Reg. No. 2,609,471  
Mark: SYDNEY OMARR'S  
Registered: August 20, 2002  
Goods: Series of books in the field of astrology
- 3) Reg. No. 2,511,751  
Mark: Louis L'Amour (stylized)  
Registered: November 27, 2001  
Goods: Series of fiction books
- 4) Reg. No. 2,151,884  
Mark: LACEY DANCER  
Registered: April 21, 1998  
Goods: Series of books, namely, romance novels
- 5) Reg. No. 2,698,054  
Mark: Dr. Seuss (stylized)  
Registered: March 18, 2003  
Goods: books and a series of books featuring children's stories
- 6) Reg. No. 2,231,032  
Mark: AGATHA CHRISTIE  
Registered: March 9, 1999  
Goods: printed matter, namely, magazines, newsletters, and newspapers featuring information of interest to mystery readers, a series of fiction books, bookmarks, and stationery
- 7) Reg. No. 2,630,156  
Mark: JRR TOLKIEN and Design  
Registered: October 8, 2002  
Goods: Series of fiction books

All of these registrations are for marks that identify the author of a series of books and that were permitted to registration by the Patent and Trademark Office. Applicant submits that the PTO's policy of permitting numerous author's names to be registered as trademarks in connection with a series of books, supports its contention that **FERN MICHAELS** is registrable.

The Trademark Examining Attorney, in her denial of Applicant's request for reconsideration, argues that the file wrappers of these seven registrations of author's names used

on a series of books are “without evidentiary value and are not binding upon the Office.” In support of this argument, the Trademark Examining Attorney has cited the following cases: *AMF Inc. v. American Leisure Products, Inc.*, 177 USPQ, 268, 269 (C.C.P.A. 1973); *In re International Taste, Inc.*, 53 USPQ2d 1604 (TTAB 2000); *In re National Novice Hockey League, Inc.*, 222 USPQ 638, 641 (TTAB 1984); *In re Consolidated Foods Corp.*, 200 USPQ 477 (TTAB 1978); and *In re Scholastic Testing Service, Inc.*, 196 USPQ 517 (TTAB). None of these cases concern themselves with the issues raised in this appeal, to wit; *AMF Inc.* and *In re National Novice Hockey League, Inc.* concerned Section 2(d) issues (similar marks had been registered), *In re International Taste, Inc.*, concerned the relevance of disclaimers in registrations made of record, and *In re Consolidated Foods Corp.* and *In re Scholastic Testing Service, Inc.*, concerned descriptiveness issues. Thus, Applicant respectfully submits that these decisions do not control whether or not the file wrappers submitted in this appeal have evidentiary value. If, on the other hand, it is the Trademark Examining Attorney’s position that the records of other registration are never of evidentiary value, this clearly does not comport with the view of the Court of Appeals for the Federal Circuit or the TTAB. Thus, in *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 1564 n. 1; 4 USPQ2d 1793, 1797 n.1 (CAFC 1987), citing, *National Data Corp.*, 753 F.2d 1056, 1059, 224 USPQ 749, 751 (CAFC 1985); *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 917, 189 USPQ 693, 694-95 (C.C.P.A. 1976). In these cases the Court recognized that third party marks which have secured Trademark Office approval, are useful as evidence of the suggestiveness of particular elements of the marks under consideration. In *In re Hamilton Bank*, 222 USPQ 174 (TTAB 1984), the TTAB concurred by noting that such third-party registrations demonstrate



... that the term or feature common to the marks has a normally understood meaning or suggestiveness in the trade and that marks containing the term or feature have been registered for the same or closely related goods or services because the remaining portions of the marks are sufficient to distinguish the marks as a whole from one another.

*Id.* at 177.

Thus, it is clear that third party registrations are of value in determining the registrability of a mark.

Applicant does agree with the Trademark Examining Attorney that the relevance of the registrations made of record require a review of the specimens of use. Applicant submits that such a review strongly supports its position that **FERN MICHAELS** is registrable for a series of books.

The most compelling registration is Reg. No. 2,151,884 for the mark LACEY DANCER. As in the application on appeal, LACEY DANCER is the pseudonym<sup>3</sup> for the author of romance novels. The specimens of record show the mark on the cover of several books in the series. The only objection raised to registration was to the identification of goods that applicant complied with.

Similarly, Reg. No. 2,345,232 for the mark PATRICIA CORNWELL includes specimens that show the name of this author on the cover and spine of books in a series and, in addition, specifically (on the inside flap of at least one of the books, identify Ms. Cornwell as the author of the books in the series. Again, the only objection to registration was to the identification of goods.

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<sup>3</sup> The record on Appeal in the **FERN MICHAELS** application includes an Internet printout confirming that LACEY DANCER is a pseudonym of applicant Sydney a. Clary.

The record concerning Reg. No. 2,511,751 for the mark Louis L'Amour (stylized) shows that applicant initially only submitted a specimen for one book in the series, showing the applied for mark on the cover page and title page of the book. In the initial Office Action, the Trademark Attorney refused registration on the same ground as in the instant Appeal; namely, that the proposed mark "does not function as a trademark, but merely identifies the author of the books. Citing *In re Spirer*, 225 USPQ 693 (TTAB 1985) and *In re Polar Music International AB*, 714 F.2d 1567, 1572, 221 USPQ 315, 318 (Fed. Cir. 1983), the Trademark Attorney argued that both (cited) cases dealt with the name of the performing group or artist as used on recordings; the issues are nearly identical and require similar treatment. Office Action, dated December 11, 2000 (emphasis supplied). In accordance with the teachings of *In re Spirer* and *In re Polar Music International AB*, the Trademark Attorney noted that he would "reconsider this refusal if the applicant submits evidence that the mark has been used on at least one book in addition to the book in the specimen of record." *Id.* Applicant complied with this suggestion (the additional specimen again showing the author's name on the cover of the book) and the application proceeded to publication.

The Trademark Examining Attorney, in her July 14, 2004 denial of Applicant's request for reconsideration, attempts to distinguish the remaining registrations made of record from the **FERN MICHAELS** application. Applicant submits that this attempt to distinguish the marks is unpersuasive and further submits that it amounts to an admission by the Trademark Examining Attorney that an author's name is registrable as a mark under certain circumstances, notwithstanding the purported holding of *In re Chicago Reader, Inc.*, 12 USPQ2d 1979 (TTAB 1989).

Thus, concerning Reg. No. 2,609,471 for the mark SYDNEY OMARR'S, the Trademark Examining Attorney claims that the mark is used as the portion of the title of several books. a review of the specimens of record does not support this conclusion. On each book cover, the mark SYDNEY OMARR'S clearly is presented as a mark independent from the other wording appearing on the cover of these books; *e.g.*, the author's name is in a typeface that is two to three times the size of the wording that the Trademark Examining Attorney considers to be the other part of the title, the mark uses a different type of font than the other wording, and the mark is expressly set off from the other wording by the use of a horizontal line, spanning across almost the entirety of the book cover's width. In fact the Trademark Attorney for SYDNEY OMARR'S required amendment of the drawing from SYDNEY OMARR to SYDNEY OMARR'S but did not refer to the wording set off from the applied mark to be part of the mark. Clearly, therefore, this registration is indistinguishable from the **FERN MICHAELS** application.

Concerning the registrations Reg. No. 2,698,054 for the mark Dr. Seuss (stylized) and Reg. No. 2,231,032 for the mark AGATHA CHRISTIE, the Trademark Examining Attorney suggest that the fact that the mark is used in advertising and promotional materials in addition to the books distinguishes these registrations from **FERN MICHAELS**. (On the books the marks are used on the covers, just as in the **FERN MICHAELS** application.) This argument clearly is fallacious: If there is a blanket prohibition against registering an author's name as a trademark for a series of books, the fact that it is also used on promotional material and advertising is immaterial to a determination of registrability. Applicant does respectfully advise that **FERN MICHAELS** has been registered, as Reg. No. 2,790,459, in connection with providing information about authors and new book releases of others by means of the Internet; providing an

on-line news column in the field of romance literature, fan club, providing a web site featuring entertainment information in the field of romance literature and featuring an on-line guest book and suggestion box; providing links to web sites of others featuring romance literature in International Class 41.<sup>4</sup> (a TARR printout of this registration is enclosed herewith as Exhibit 1. Applicant respectfully submits that this printout should be considered in connection with this appeal as the Trademark Examining Attorney only raised this issue after Applicant had completed the record on appeal.) Clearly, Applicant should not be penalized because it chose to apply for a series of books in one application and for services that show use of the mark on advertising and/or promotional materials in another application, rather than combining these goods and services in one application.

Finally, concerning Reg. No. 2,630,156 for the mark JRR TOLKIEN and Design, the Trademark Examining Attorney argues that this mark is distinguishable from **FERN MICHAELS** because it includes a design, comprising the author's initials JRR, in addition to the author's last name. (The author's name also is shown in moderately stylized block lettering on the covers and spines of the books in the series.) a review of the record of this registration clearly confirms that there can be no doubt that the entire name, including the initials is the name of the author; in response to the Examining Attorney's inquiry, applicant advised the "[t]he name as used in the mark does not identify a particular living individual. Rather, the name identifies the deceased author J.R.R. Tolkien." Applicant's March 26, 2001 response to Office Action

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<sup>4</sup> Interestingly enough, Ms. Richards was the Examining Attorney of this registration also.

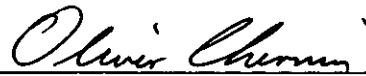
(emphasis supplied). Accordingly, there does not appear to be any basis for distinguishing this registration from the **FERN MICHAELS** application.

The records of these registrations confirm Applicant's argument that author's names are registrable when used in connection with a series of books.

**V. SUMMARY**

Based upon the foregoing, Applicant believes that the Trademark Attorney's refusal to register Applicant's mark must be reversed. The case law clearly supports Applicant's position that an author's name is registrable as a trademark for a series where it serves as an identifier of the products. Moreover, the records of the PTO reflect that Applicant's position has, in fact, already been accepted. Therefore, applicant respectfully submits that the applied for mark **FERN MICHAELS** is entitled to registration for a series of books and that the refusal to register should be reversed.

Respectfully submitted,

A handwritten signature in cursive script, reading "Oliver R. Chernin", is written over a horizontal line.

Oliver R. Chernin  
Attorneys for Applicant  
McLaughlin & Stern, LLP  
260 Madison Avenue  
New York, New York 10016  
(212) 448-1100

Enclosures: TARR printout of Reg. No. 2, 790,459 **FERN MICHAELS**

EXHIBIT 1

**Thank you for your request. Here are the latest results from the TARR web server.**

**This page was generated by the TARR system on 2004-09-14 18:25:47 ET**

**Serial Number:** 76420624

**Registration Number:** 2790459

**Mark (words only):** FERN MICHAELS

**Standard Character claim:** No

**Current Status:** Registered.

**Date of Status:** 2003-12-09

**Filing Date:** 2002-06-13

**Transformed into a National Application:** No

**Registration Date:** 2003-12-09

**Register:** Principal

**Law Office Assigned:** LAW OFFICE 106

**If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at [TrademarkAssistanceCenter@uspto.gov](mailto:TrademarkAssistanceCenter@uspto.gov)**

**Current Location:** 900 -Warehouse (Newington)

**Date In Location:** 2003-12-15

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#### **LAST APPLICANT(S)/OWNER(S) OF RECORD**

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1. First Draft, Inc.

**Address:**

First Draft, Inc.  
1006 South Main Street  
Summerville, SC 29483  
United States

**Legal Entity Type:** Corporation

**State or Country of Incorporation:** Delaware

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#### **GOODS AND/OR SERVICES**

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**International Class:** 041

providing information about authors and new book releases of others by means of the Internet; providing an on-line news column in the field of romance literature, fan club, providing a web site featuring entertainment information in the field of romance literature and featuring an on-line guest book and suggestion box; providing links to web sites of others featuring romance literature

**First Use Date:** 1996-05-00

**First Use in Commerce Date:** 1996-05-00

**Basis:** 1(a)

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**ADDITIONAL INFORMATION**

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**Name Portrait Consent:** The name in the mark identifies a living individual whose consent is of record.

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**MADRID PROTOCOL INFORMATION**

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(NOT AVAILABLE)

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**PROSECUTION HISTORY**

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2003-12-09 - Registered - Principal Register

2003-09-16 - Published for opposition

2003-08-27 - Notice of publication

2003-07-15 - Approved for Pub - Principal Register (Initial exam)

2003-05-23 - Correspondence Received In Law Office

2003-05-23 - PAPER RECEIVED

2003-02-05 - Non-final action mailed

2002-12-06 - Case file assigned to examining attorney

2002-07-31 - PAPER RECEIVED

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**CONTACT INFORMATION**

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**Correspondent**

Oliver R. Chernin, Esq. (Attorney of record)

OLIVER R. CHERNIN, ESQ.  
MCLAUGHLIN & STERN, LLP  
260 MADISON AVENUE  
NEW YORK, NEW YORK 10016

**Phone Number:** (212)448-1100

**Fax Number:** (212) 448-0066